

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KEVIN W. FREEMAN ET AL.

For: CONNECTOR FOR A BUILDING TRUSS WITH INTEGRAL MOUNTING TO SUPPORTING STRUCTURE

Serial No.: 10/605,595 Examiner: William V. Gilbert

Filed: October 10, 2003 Group Art Unit: 3635

Atty. Docket: 71198-0062 Confirmation No: 2594

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

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Commissioner for Patents
PO Box 1450
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Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This paper is responsive to the Office Action mailed March 17, 2006, as follows:

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-68 were in the application as filed. The Examiner has required restriction between allegedly patentably distinct Species 1 (Figures 1-4), Species 2 (Figures 20-23), Species 3 (Figures 30-33), Species 4 (Figure 37), Species 5 (Figures 38-41), and Species 6 (Figures 45 and 46). The Examiner asserts that claim 1 is generic. Applicants submit that claim 54 is also generic. Applicants request that the Examiner consider the withdrawal of the restriction requirement in light of the arguments advanced herein. Alternatively, Applicants provisionally elect the claims of Species 3, claims 1-11, 14-16, 19-27, 30-34, 37-44, and 47-66, with traverse.

The Examiner has required restriction between alleged Species 1 (claims 1-4), Species 2 (claims 5-14), Species 3 (claims 15-24), and Species 4 (claims 25-36), each of which comprises a connector strap for a building truss. The connector strap comprises a web, first and second sidestep portions, a hinge portion in the web, and mounting portions associated with the web and the sidestep portions. The restriction requirement is respectfully traversed as being improper.

Restriction may be required if two or more "independent and distinct" inventions are claimed in one application. 35 U.S.C. §121. Alleged Species 1-6 have the unifying concept of a connector strap for a building truss comprising a web, first and second sidestep portions, a hinge portion in the web, and mounting portions associated with the web and the sidestep portions. Thus, the species are not independent and distinct.

As the Examiner is undoubtedly aware, 37 CFR 1.141(a) states:

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

See, also, Manual of Patent Examining Procedure, §§806.04(a), 806.04(h). Thus, 37 CFR 1.141(a) recognizes that a single application can properly include claims to a reasonable number of species greater than one provided the application includes an allowable generic

claim from which the species claims depend. This is precisely the situation with respect to the Application at issue. While no decision has yet been made concerning the allowability of the generic claims, the species claims must be examined if a claim generic to the species is allowed. *See, MPEP §809.02(c).*

Moreover, a search of the prior art would not be duplicative and Applicants are at a loss as to how the Examiner would be burdened by having to examine all the groups of claims since they relate to such intertwined subject matter.

There is good reason to maintain all species claims in the application for examination pending allowance of the generic claim. Each species operates in essentially the same general manner. The differences lie in the configuration of the mounting portions associated with the web and the sidestep portions, and the relative positioning of the sidestep portions. The number of species, i.e. 6, is not unreasonable. Only 12 claims out of a total of 68 would be withdrawn. The burden of maintaining all claims in the application is negligible, and far outweighed by the burden of continuing examination of the withdrawn claims in separate applications. Nevertheless, Applicants confirm a provisional election with traverse of alleged Species 3, claims 1-11, 14-16, 19-27, 30-34, 37-44, and 47-66.

Election of Species

Applicants provisionally elect alleged Species 3, claims 1-11, 14-16, 19-27, 30-34, 37-44, and 47-66, with traverse.

The Examiner states that claim 1 is generic. Applicants submit that claim 54 is also generic. As the Examiner is undoubtedly aware, MPEP §809.02(c) states:

(B) When a generic claim is subsequently found to be allowable, and not more than a reasonable number of additional species are claimed, treatment shall be as follows:

(1) When all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that **claims drawn to the**

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nonelected species are no longer withdrawn since they are fully embraced by the allowed generic claim. (Emphasis added.)

Upon the allowance of either claim 1 or claim 54, Applicants will be entitled to consideration of dependent claims 12, 13, 17, 18, 28, 29, 35, 36, 45, 46, 67, and 68 as drawn to species which are non-elected as a result of the restriction requirement. *See, 37 CFR 1.146.*

CONCLUSION

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

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Dated: May 10, 2006

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